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Matheson/ Keys PLLC 7004 Bee Cave Rd. Austin, TX 78746				XU, XIAOYUN
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DALE SPALL, TODD M. ALLEN, ROY GOELLER,  
and PETER KOTTENSTETTE

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Appeal 2010-000680  
Application 10/628,072  
Technology Center 1700

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Decided: June 11, 2010

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Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and  
CATHERINE Q. TIMM, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 51-55, 57, and 59-61. Claims 12-19, and 21-25 have been allowed and claim 56 is objected to. We have jurisdiction under 35 U.S.C. § 6(b).

Claim 51 is illustrative:

51. A liquid marker compound comprising:

a first marker having a molar absorptivity of approximately  $5 \times 10^4 \text{ L}$  mole $^{-1}$  cm $^{-1}$  or greater in the wavelength range of about 600 to 1000 nm; and

a second marker wherein the second marker is a molecular marker, and wherein a molecular weight of the second marker is artificially enhanced with a non-radioactive isotope.

The Examiner relies upon the following references as evidence of obviousness (Ans. 3):

Atkinson	3,746,634	July 17, 1973
Anderson '937	5,474,937	Dec. 12, 1995
Anderson '283	5,981,283	Nov. 09, 1999
Meyer	6,312,958 B1	Nov. 06, 2001

Appellants' claimed invention is directed to a marker for a liquid comprising a first marker having the recited molar absorptivity and a second molecular marker that is artificially enhanced with a non-radioactive isotope.

The appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

- (a) claims 51-54 and 59-61 over Meyer in view of Anderson '937,
- (b) claim 55 over Meyer in view of Anderson '937 and Atkinson, and
- (c) claim 57 over Meyer in view of Anderson '937, Atkinson, and Anderson '283.

Appellants present a separate, substantive argument only for claim 55. Accordingly, claims 51-54 and 59-61 stand or fall together.

We have thoroughly reviewed each of Appellants' arguments for patentability. However, we are in complete agreement with the Examiner

that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the Examiner's rejections for essentially those reasons expressed in the Answer.

There is no dispute that Meyer, like Appellants, discloses a marker for identifying liquids comprising the claimed first marker having the recited molar absorptivity, in addition to a second marker that is distinct from the first marker. Appellants contend that the second marker of Meyer is not their "high reliability molecular marker" (App. Br. 3, last para.). However, we agree with the Examiner that the second marker of Meyer qualifies as a molecular marker inasmuch as it marks or identifies a molecular liquid. As noted by the Examiner, the appealed claims do not recite that the second marker is a "high reliability" marker, nor, for that matter, do the claims recite that the first marker is a low reliability marker.

Appellants urge that "the Specification clearly distinguishes between a lower reliability absorption marker and a higher reliability molecular marker and defines them as being distinct" (App. Br. 4, second para.). However, it is by now axiomatic that limitations found in the Specification are not to be read into the claims. Also, although Appellants point to the Specification disclosure that "[t]he high reliability molecular marker allows for an exact determination of the concentration of marker present thus allowing an exact identification of the liquid" (Reply Br. 2, first full sentence), such disclosure does not define the claimed "molecular marker" as, necessarily, a high reliability marker.

The Examiner appreciates that Meyer does not expressly teach that the second marker is artificially enhanced with a non-radioactive isotope, as

presently claimed. However, there is no dispute that Anderson ‘937 discloses the use of a marker for liquids of the type disclosed by Meyer that is artificially enhanced with a non-radioactive isotope. Accordingly, we agree with the Examiner that it would have been obvious for one of ordinary skill in the art to use the non-radioactive isotope-enhanced marker of Anderson ‘937 in addition to, or as a replacement for, the markers used by Meyers. We find this especially so since, as pointed out by the Examiner, Anderson ‘937 expressly teaches that the chemical marker may be a non-radioactive isotope of the chemical being shipped (col. 4, ll. 1-2), and that the chemical marker may be an organic solvent which, significantly, is the same material being marked and shipped by Meyer, such as acetone, octane, toluene, etc. Hence, it would have been obvious for one of ordinary skill in the art to use a marker that is a non-radioactive isotope of the solvent being shipped by Meyer in order to enhance compatibility between the solvent and the marker.

As for separately argued claim 55 which defines the second marker as a polynuclear aromatic hydrocarbon, we find that the exemplary aromatic markers disclosed by Anderson ‘937 would have suggested polynuclear aromatic hydrocarbons to one of ordinary skill in the art, particularly since Anderson ‘937 cites Atkinson for deuterated polynuclear aromatic hydrocarbons as chemical markers. The disclosure of Anderson ‘937 of deuterated organic compounds, wherein the hydrogen atoms covalently bound to carbon atoms are replaced with deuterium atoms, would include saturated and unsaturated compounds.

Appellants advance no additional arguments directed to the Examiner’s additional evidence and reasoning relied upon to reject claim 57,

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and, therefore, the rejection of that claim is sustained for the reasons articulated above.

As a final point, we note that Appellants base no argument upon objective evidence of non-obviousness, such as unexpected results.

In conclusion, based on the foregoing, the Examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2008).

AFFIRMED

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